



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Ronald L. Smith

Serial No.: 08/586,777

Filed: 12/07/1995

For: PORTABLE COMPUTER HAVING AN INTERFACE FOR DIRECT  
CONNECTION TO A MOBILE TELEPHONE

Docket No.: TI-22187

Art Unit: 2112

Examiner: Myers, Paul R.

Conf. No.: 7439

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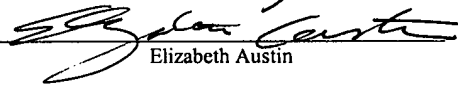
PETITION FOR WITHDRAWAL OF PREMATURE FINAL REJECTION

37 C.F.R. § 1.181

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-14550

MAILING CERTIFICATE UNDER 37 C.F.R. § 1.8(a)

I hereby certify, that on this date, this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Alexandria, VA 22313-1450 on May 25, 2005.

  
Elizabeth Austin

Dear Sir:

The USPTO mailed an Office communication finally rejecting Claims 15-28 and 30-46 in the above-identified application on April 29, 2005. Applicants hereby petition the Commissioner under 37 C.F.R. 1.181 to invoke his supervisory authority and order the withdrawal of the final rejection, for the reasons set forth below.

THE FACTS:

- 1) The Examiner canceled Claims 8-11 by Examiner's amendment on May 20, 2002. The Examiner, however, was without authority to cancel Claims 8-11 the rejection of which was REVERSED by the Board of Appeals in its Decision on Appeal dated March 8, 2002

(see page 7, line 11 – page 8, line 3 & page 9, lines 9-10). [The Examiner's actions were prohibited under 37 CFR 1.198; MPEP 1214.07; & MPEP 1406] Accordingly, there was no rejection pending on Claims 8-11.

- 2) In an amendment dated December 29, 2004, Applicants pointed out that the Examiner was without authority to cancel Claims 8-11, the rejection of which had been reversed by the Board of Appeals. Accordingly, Applicants argued that Claims 8-11 remained pending and were allowable in response to the reversal by the Board of Appeals. Again, there was no rejection pending on Claims 8-11.
- 3) The Examiner admits his mistake in canceling Claims 8-11 in an Office Action dated April 29, 2005. The Examiner goes on to explain that he has since been instructed to treat canceled Claims 8-11 as newly added Claims 43-46. The Examiner then proceeds to issue a Final Rejection (not a non-final rejection) on Claims 43-46 under the following grounds of rejections presented for the first time in the Office Action dated April 29, 2005: Claims 43-44 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sinton PN 5,249,218 in view of Morris PN 5,020,090; Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sinton PN 5,249,218 in view of Morris PN 5,020,090 as applied to claim 43 above and further in view of Kobayashi PN 5,111,361; and Claims 43-44 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hop PN 4,912,756 in view of Morris PN 5,020,090

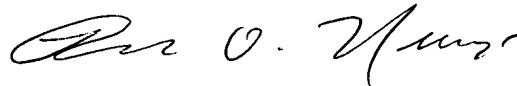
### **ARGUMENT**

There was no rejection pending on Claims 8-11 or 43-46 prior to the rejection of Claims 43-46 issued by the Examiner on April 29, 2005. As such, issuing a FINAL rejection on Claims 43-46 was clearly premature. Moreover, Claims 43-46 are word for word identical to Claims 8-11 the rejection of which was reversed by the Board of Appeals and should be treated no

differently in prosecution whether they are identified as Claims 8-11 or 43-46 and should be treated as if they were present in the application before and after March 4, 2003. Accordingly, Applicants respectfully petition the Commissioner to withdraw the finality of the rejection issued by the Examiner on April 29, 2005.

While Applicants could find no fee associated with petitions under 37 C.F.R. § 1.181, if there is a fee, please charge the fee to Deposit Account No. 20-0668. Three copies of this sheet are enclosed.

Respectfully submitted,



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